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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,228	10/28/2003	Steven J. Smith	MNDSH-01003US0	4973
23910 7590 07/25/2007 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER LAI, MICHAEL C	
			ART UNIT 2109	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,228

Applicant(s)

SMITH ET AL.

Examiner

Michael C. Lai

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/26/2005; 05/03/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. This application has no priority claim made. The filing date is 10/28/2003

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 41-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. These claims are single means claims. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08(a).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 40 recites the limitation of "A computer data signal embodied in a transmission medium, comprising..." A signal or a transmission medium is not tangible. Thus it is not statutory. The rest of claim talks about same limitations recited in claim 1. Claim 41 is a program version of claim 1. It is recommended that claim 40 is to be cancelled.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 41-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gans et al. (US 6,216,127 B1), hereinafter referred to as Gans. Gans shows all the structure of the claims, i.e., a machine readable medium having instructions stored thereon. The remainder of the claims are deemed to be functional or intended use and which Gans is fully capable of performing.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-40, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gans et al. (US 6,216,127 B1), hereinafter referred to as Gans, in view of Langseth et al. (US 6,671,715 B1), hereinafter referred to as Langseth.

- a) Regarding claims 1, 20, 39 and 40, Gans discloses a method for governing the delivery rate of electronic mail (email) messages, said method comprising: providing a plurality of mail transfer agents (MTAs) that are capable of delivering email simultaneously (col. 4, lines 14-16: process emails in parallel; col. 5, lines 25-28: The number and characteristics of processes can be determined or altered by a electronic mail system administrator based on such factors as system activity levels.);
- Gans doesn't disclose: controlling the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery efficiency is based on the performance of the plurality of MTAs.
- Langseth discloses: controlling the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery

efficiency is based on the performance of the plurality of MTAs (col. 16, line 33 – col. 17, line 6: load balancing and fault tolerance).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to control the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery efficiency is based on the performance of the plurality of MTAs. The motivation would be to achieve load balancing and resource management.

- b) Regarding claims 2 and 21, Gans further discloses: the controlling is accomplished by increasing or decreasing the number of MTAs in the plurality of MTAs that can be allocated for delivering email (col. 8, lines 28-37: Based on a comparison of the two snapshots and the configuration information, the guardian can determine whether or not to initiate, restart, or stop one or more processes.).
- c) Regarding claims 3, 12, 22 and 31, Gans further discloses: the controlling is accomplished by de-allocating MTAs in the plurality of MTAs that are in use (col. 8, lines 28-37: Based on a comparison of the two snapshots and the configuration information, the guardian can determine whether or not to stop one or more processes.).
- d) Regarding claims 4, 13, 23 and 32, Gans doesn't disclose: controlling the rate of delivery based on MTA utilization. However, Langseth discloses controlling the rate of delivery based on MTA utilization (col. 13, line 14 –

col. 14, line 7: resource management). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to control the rate of delivery based on MTA utilization. The motivation would be to maximize the resource utilization.

- e) Regarding claims 5, 14, 24 and 33, Gans further discloses: the delivery efficiency is based on email message throughput over a period of time and the average number of allocated MTAs in the plurality of MTAs over the period of time (col. 5, lines 25-28: The number and characteristics of processes can be determined or altered by a electronic mail system administrator based on such factors as system activity levels.).
- f) Regarding claims 6, 15, 25 and 34, Gans further discloses: the controlling is continuous or periodic (Abstract: a guardian process examines system information periodically and identifies any need to initiate, restart, or stop one or more processes.).
- g) Regarding claims 7, 16, 26 and 35, Gans further discloses: the plurality of MTAs can execute on one or more servers (FIG. 1A, col. 4, lines 27-31: Server A 104 and Server B 106 have been configured to process mail entries in queue 102).
- h) Regarding claims 8, 17, 27 and 36, Gans further discloses that an MTA can be restarted if it fails (col. 8, lines 28-37: Based on a comparison of the two

snapshots and the configuration information, the guardian can determine whether or not to restart one or more processes.).

- i) Regarding claims 9, 18, 28 and 37, Gans doesn't disclose: an MTA can personalize an email message. However, Langseth discloses that an MTA can personalize an email message (col. 4, lines 28-30: Each subscriber may also select to personalize the service content (email)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to personalize an email message. The motivation would be to achieve customer satisfaction by providing them choice of preferences for style of content, information etc.

- j) Regarding claims 10, 19, 29 and 38, Gans doesn't disclose: adjusting an MTA email message delivery retry limit based on one of: 1) a number of allocated MTAs; 2) delivery failure rate; 3) a number of allocated MTAs and a delivery failure rate; 4) stage of message delivery; and 5) utilization of the plurality of MTAs. However, Langseth discloses adjusting an MTA email message delivery retry limit based on delivery failure rate (col.19, lines 42-47: retries to send the message at a user-defined interval and number of attempts. If it fails to send the message after these attempts, it places the message in the BadMail folder where it stays for human intervention).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to

adjust an MTA email message delivery retry limit based on one of: 1) a number of allocated MTAs; 2) delivery failure rate; 3) a number of allocated MTAs and a delivery failure rate; 4) stage of message delivery; and 5) utilization of the plurality of MTAs. The motivation would be to maximize mail delivery success rate and help achieve customer total satisfaction.

- k) Claims 11 and 30 talk about the limitations of claim 1 plus the following: tracking over time delivery efficiency for the plurality of MTAs; wherein the controlling is accomplished by increasing or decreasing the number of MTAs in the plurality of MTAs that can be allocated for delivering email. Claim 1 is rejected as discussed above. Gans further discloses: tracking over time delivery efficiency for the plurality of MTAs; wherein the controlling is accomplished by increasing or decreasing the number of MTAs in the plurality of MTAs that can be allocated for delivering email (col. 8, lines 28-37: Based on a comparison of the two snapshots and the configuration information, the guardian can determine whether or not to initiate, restart, or stop one or more processes.).
- l) Regarding claim 51, Gans discloses a method for governing the delivery rate of electronic mail (email) messages, said method comprising: providing a plurality of mail transfer agents (MTAs) that are capable of delivering email simultaneously (col. 4, lines 14-16: process emails in parallel; col. 5, lines 25-28: The number and characteristics of processes can be determined or altered by a electronic mail system administrator based on such factors as

system activity levels.). Gans doesn't disclose: automatically adjusting a email message retry limit for the plurality of MTAs; and wherein an MTA in the plurality of MTAs can be allocated for delivering email. However, Langseth discloses automatically adjusting a email message retry limit for the plurality of MTAs (col.19, lines 42-47: retries to send the message at a user-defined interval and number of attempts. If it fails to send the message after these attempts, it places the message in the BadMail folder where it stays for human intervention); and wherein an MTA in the plurality of MTAs can be allocated for delivering email. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to automatically adjusting a email message retry limit for the plurality of MTAs; and wherein an MTA in the plurality of MTAs can be allocated for delivering email.. The motivation would be to maximize mail delivery success rate and help achieve customer total satisfaction.

- m) Regarding claim 52, Gans doesn't disclose: controlling the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery efficiency is based on the performance of the plurality of MTAs. However, Langseth discloses: controlling the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery efficiency is based on the performance of the plurality of MTAs (col. 16, line 33 – col. 17, line 6: load balancing and fault tolerance).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to control the rate of the email delivery based on delivery efficiency and a target delivery rate; and wherein the delivery efficiency is based on the performance of the plurality of MTAs. The motivation would be to achieve load balancing and resource management.

- n) Regarding claim 53, Gans doesn't disclose: adjusting an MTA email message delivery retry limit is based on one of: 1) a number of allocated MTAs; 2) delivery failure rate; 3) a number of allocated MTAs and a delivery failure rate; 4) stage of message delivery; and 5) utilization of the plurality of MTAs. However, Langseth discloses adjusting an MTA email message delivery retry limit based on delivery failure rate (col.19, lines 42-47: retries to send the message at a user-defined interval and number of attempts. If it fails to send the message after these attempts, it places the message in the BadMail folder where it stays for human intervention).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Langseth into Gans' method to adjust an MTA email message delivery retry limit based on one of: 1) a number of allocated MTAs; 2) delivery failure rate; 3) a number of allocated MTAs and a delivery failure rate; 4) stage of message delivery; and 5) utilization of the plurality of MTAs. The motivation would be to maximize mail delivery success rate and help achieve customer total satisfaction.

9. Claims 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gans in view of Langseth, and further in view of Limprecht et al. (US 20040205124 A1), hereinafter referred to as Limprecht.

- a) Claims 54-59 describe the limitations of adjusting the retry limit under different situations: (claims 54-55) the retry limit is reduced/increased if a number of allocated MTAs in the plurality of MTAs exceeds/falls below a value; (claims 56-57) the retry limit is decreased/increased if an email delivery failure rate exceeds/falls below a value; (claim 58) the retry limit decreases as is later stages of message delivery; (claim 59) the retry limit is inversely proportionate to utilization of the plurality of MTAs.
- b) Together Gans and Langseth disclose the limitations of claim 51 as shown above. Gans and Langseth do not disclose the limitations of adjusting the retry limit under different situations. However, Limprecht discloses the limitations of adjusting the retry limit under different situations (page 8, paragraph 0074: fault handler, transmission and delivery retry and the fault and repair model allow Dialogs to many environmental changes...scalable deployment options...).
- c) It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Limprecht into Gans' and Langseth's method to adjust the retry limit under different situations. The motivation would be to improve availability and scalability.

Art Unit: 2143

Remarks

10. The following pertaining arts are discovered and not used in this office action.

Office reserves the right to use these arts in later actions.

- Williams et al. (US 5,424,724) Method and Apparatus for Enhanced Electronic Mail Distribution
- Costales et al. (US 6,044,395) Method and Apparatus for Distributing Personalized Mail

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (571) 272-5026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
20JULY2007

A handwritten signature in black ink, appearing to read 'Marvin Lateef', with a stylized, cursive script.

MARVIN M. LATEEF
SUPERVISORY PATENT EXAMINER